

U.S. Serial No. 09/840,811
Attorney Docket No. NL 000251

REMARKS

Claims 1-10 are in the case and presented for consideration.

The applicant and the undersigned thank the Supervisory Patent Examiner for the courtesies extended during the recent telephone interview concerning this application. A summary of the interview is provided following this section of the response.

Claim 5 was amended because it was presented in improper form due to a multiple dependent claim being dependent from another multiple dependent claim. Claim 5 has been amended to remove the improper multiple dependency only, and not for any other reason.

Claims 9-10 were added to recite additional features.

In the present Office Action, the Office has rejected claim 4 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office states that applicant has not described a "HomePNA communication system." Applicant has amended the specification to point out that HomePNA™ is a trademark of the Home Phoneline Networking Alliance, Inc., which is a group of network industry companies that have created a phone line networking standard. Page 1, lines 11-13 of the specification introduce HomePNA™ by referring to "The Home Phoneline Networking Alliance, A White Paper, June 1998" which can be found at <http://www.homepna.org/docs/wp1.htm> and describes the technology in more detail. One having ordinary skill in the art

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would have sufficient information from the HomePNA™ URL in the specification to practice the invention as claimed. Therefore, applicant submits that claim 4 contains subject matter which is described in the specification with sufficient information to enable one having ordinary skill in the art to practice the invention.

In addition, the Office rejected claims 1-8 under 35 U.S.C. 102(e) as being anticipated by published U.S. Patent Application 2003/0133558 Kung et al.

Applicant respectfully submits that the Office has failed to establish a *prima facie* case of anticipation because it has not addressed several elements and limitations in the claims. It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the United States Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To meet the burden of establishing a *prima facie* case of anticipation, the Office must explain how the rejected claims are anticipated by pointing out where the specific limitations of the claims are found in the prior art. If the Patent Office does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to a grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

Turning to the Office Action, the Office states:

"Kung et al Fig. 3 shows a residential communication system comprising gateway (300), and describes it in [0028] that it may be separated into more than one physical device allowing functionality to be distributed to a plurality of different locations in the customer premises or network 1."

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Thus, in the first sentence, the Office seems to address the claimed telephone gateways (4) and (8) in claim 1. Then, the Office indicates, "Kung et al. disclose a least cost router 255" which seems to address claim 2. Next, the Office explains:

"Router 255 also provides gateways users the capability to select between cost and QoS. Fig. 2 of Kung et al. shows multiple gateways 230, 232, 234, 236, 238, 240 along with least cost router 255."

Again, the Office points out gateways and discusses cost.

The Office fails to address the following claimed elements of claim 1:

- station(s) (6) and
- non-residential telephone network(s) (12) and (14).

The Office also does not address the majority of the claimed limitations of claim 1, such as for example:

"the further telephone gateway (8) being arranged for receiving the at least part of the out-going telephone signals via the communication network (10) from the telephone gateway (4) and for supplying the at least part of the out-going telephone signals to a further non-residential telephone network (14)."

Although the Office points out that the gateway 300 may be separated into more than one physical device in network 1, the Office does not show that a first telephone gateway is arranged to receive at least part of out-going telephone signals via a communication network from a second telephone gateway. Nor does the Office show that the first telephone gateway supplies at least part of the out-

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going telephone signals to a further non-residential telephone network.

Similarly, the Office has not addressed elements and limitations in the other claims. For example, the Office does not identify where the prior art discloses that "the further telephone gateway (8) is comprised in a set-top box," as recited in claim 5. Claims 7 and 8 also recite limitations, which do not appear to have been considered by the Office, such as the supply of first and second parts of out-going telephone signals to various recited elements. As the Office is no doubt aware, all limitations of a claim must be considered meaningful, and, "the PTO must consider all claim limitations when determining patentability of an invention over the prior art." *In Re Lowry*, 32 USPQ2d 1031, 1034 (Fed Cir. 1994). Although applicant has provided several examples of elements and limitations not considered or discussed by the Office, this list is not exhaustive. The Office has essentially failed to discuss the relevance of the prior art to the majority of the claimed elements and limitations.

Because the Office did not address most of the elements and limitations of the claims in the Office Action, the Office has not satisfied the burden of establishing a *prima facie* case of anticipation. Without more, applicant is entitled to the grant of a patent. If the Office believes that the cited reference discloses all of the claimed elements and limitations, it must discuss which portions of the cited reference disclose each and every claimed element and limitation. In the discussion, the Office should refer to specific columns and line numbers in the cited reference. For the above-mentioned reasons, applicant respectfully requests that

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the Office avoid or refrain from issuing a Final Office Action in response to applicant's reply, if the rejection is maintained.

Moreover, applicant respectfully submits that claims 1-10 are patentable because they recite at least one element or limitation not taught or suggested by the prior art. For example, claim 1 recites:

"the telephone gateway (4) being arranged for transmitting at least part of the out-going telephone signals via the communication network (10) to the further telephone gateway (8)"

The undersigned has carefully reviewed the cited reference and cannot locate any disclosure or suggestion that one telephone gateway is arranged for transmitting at least part of out-going telephone signals via a communication network to a further telephone gateway. Consequently, the cited reference also does not teach or suggest:

"the further telephone gateway (8) being arranged for receiving the at least part of the out-going telephone signals via the communication network (10) from the telephone gateway (4) and for supplying the at least part of the out-going telephone signals to a further non-residential telephone network (14)."

Claims 2-6 are dependent from claim 1 and are believed to be patentable for at least the same reasons as claim 1. Furthermore, the undersigned has carefully reviewed the cited reference and is unable to find any disclosure or suggestion that "the further telephone gateway (8) is comprised in a set-top box," as recited in claim 5.

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Claims 7-8 recite elements and limitations similar to those recited in claim 1 and therefore are believed to be patentable for at least the same reasons as claim 1, as described above. Therefore, new claims 9-10, which are dependent from claim 8, are also deemed patentable.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

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SUMMARY OF THE INTERVIEW

On February 10, 2005, the undersigned participated in an interview with Examiner Fan S. Tsang, Supervisory Patent Examiner (SPE) of Art Unit 2645 since Examiner Creighton Smith was unavailable.

First, the undersigned pointed out that "HomePNA" is a trademark and suggesting amending the specification and claims accordingly. The SPE indicated that such action should overcome the §112 objection.

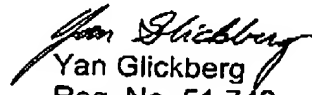
Second, the undersigned sought clarification of the §102(e) rejection because many of the elements and limitations recited in the claims are not discussed or compared to the cited prior art. Upon reviewing the case, the SPE explained that he could not be certain as to which features of the prior art anticipate the claims in light of the lack of explanation in the Office Action, and that any objections or arguments should be noted in the response to the Office Action.

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If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

The Commissioner is hereby authorized to credit any overpayment or charge any fee (except the issue fee) to Account No. 14-1270.

Respectfully submitted,


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